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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/442,152

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This communication is responsive to response filed on January 02, 2003.

Applicant adds new claim 13.

#### *Response to Applicant's Remarks*

1. Applicant remarks that Dubbels et al fails to teach a printing means that comprises a first request means, structural means, setting means, second request means, means for generating print data as required by claims 1, 6 and 10.

Dubbels et al teaches "An apparatus and method for printing related web pages" (Abstract; col. 1, lines 64-67) and "The method and apparatus of the present invention has particular applicability to printing web pages on the Internet." (col. 2, lines 50-51). Thus, the apparatus (Fig.1) in Dubbels is equivalent to a printer or is considered as a printer since it is for printing. From the last office action, the printer in Dubbels includes the claimed features although Dubbels does not directly teach the structure means for determining a structure of the resource. Huttenlocher et al, which teaches HTML document with marked up structure which is determined by the decomposer or decompressor (71, Fig. 7), is combined with Dubbels since both of them teach a printing apparatus for printing web pages.

2. Applicant remarks that the claimed invention provides a printing means capable of directly obtaining a resource from a server and printing such a resource without a computer.

From Fig. 5, the printing apparatus 200 directly obtains a resource from a (web) server 220 via Internet. Dubbels further teaches that the Web Page Print Mechanism 128 is separate

from the web browser 210 (col. 6, line 62 – col. 7, line 15). Thus, the printing apparatus 200 may be generated the print request to the server by using the Web Page Print Mechanism 128 rather than the web browser 210.

It is note that Applicant argues limitations that are not in the claims. There is no claim claiming the printing of a resource without a computer. The Specification is not the measure of the invention. Therefore, limitations contained therein cannot be read into the claims for the purpose of avoiding the prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

The rejection of claims 1-12 is maintained.

### ***Drawings***

3. The drawings are objected to because “messate” in STEP 601, Fig.6 should be –message–; “passible” in STEP 804, Fig.8 should be – possible--; “farmat” in Fig.10 should be –format--.; “printablae” in STEP 1103, Fig.11 should be –printable--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

4. Claim 10 is objected to because of the following informalities: “mudule” in line 4 should be –module--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels et al (US Patent No. 6,222,634) in view of Huttenlocher et al (US Patent No. 6,011,905)..

Concerning claim 1, Dubbels et al discloses a printer system (Fig.5) comprising a first request means (210) which makes a first request for obtaining a resource from a server (610, Fig.6); listing means (540) for determining a list of the resource based on the response from the server (630; Fig.6; Figs.7-8; col. 8, lines 1-38); setting means (540) for setting pages to be printed based on the structure of the determined source (col. 7, lines 16-17); second request means (550) which makes a second request for obtaining structural data within the set pages to be printed (col. 7, lines 17-20); means (560) for generating print data based on the second response; and printing means (printer) for printing based on the generated print data (Figs.5-8; Abstract; col. 2, lines 60-62; col. 4, line 61 – col. 5, line 5; col. 6, line 62 – col. 8, line 64).

Dubbels fails to directly teach a structure means for determining a structure of the resource. However, Dubbels teaches a list of web pages, generally written in Hypertext Markup Language (HTML), for the user to select what pages to print. From Fig.7, a list of information resource in different formats such as graphical interface GIF and JPG, and links 740 and 750 allowing a user to go to these related web pages. When all the related links are passed and a list of related links is built, a display 800 results (Fig.8) which includes a list 810 of related links and

Art Unit: 2622

a button 820 for the user to select pages to be printed (col. 8, lines 1-38). Huttenlocher et al teaches in the Background of the Invention that HTML allows markup of the structure of the document (col. 1, line 66 – col. 2, line 20). It would have been obvious to one skilled in the art at the time the invention was made to consider Dubbels teaches the determination of the structure of the resource based on the teaching of Huttenlocher since both of them teach the use of the HTML while Dubbels teaches in Figs.7-8, the information equivalent to the structure of the resource.

Concerning claims 2-3, Dubbels et al fails to teach a judgment means for judging the data format of the structural data and whether the structural data is printable data. However, Dubbels teaches that when web server 220 receives a web page request, it will build a web page in HTML and send it off across the Internet 170 to the requesting web browser 210. Web browser 210 understands HTML and interprets it and outputs the web page to the monitor of user workstation 200 wherein the web page may contain text, graphics, and links (col. 3, lines 8-18). Fig.7 shows different formats that the web browser has to judge in order to convert them into printable data (col. 8, lines 1-38). It would have been obvious to one skilled in the art at the time the invention was made to consider the system at the web client includes a judging means for judging the data format of the structural data since the web browser 210 interprets it in different formats and outputs the web page to the monitor (col. 2, lines 60-62; col. 3, lines 13-18; col. 4, line 61 – col. 5, line 5; col. 8, lines 55-64).

Concerning claims 4-5, 11-12, Dubbels fails to teach that the data format is moving picture data and the second request means obtains the structural data with the offset value from the top position of the resource. Huttenlocher et al teaches that “HTML provides somewhat

Art Unit: 2622

more flexibility than ASCII, in that it supports embedded graphics, images, audio and video recordings, and hypertext linking capabilities.” (col. 2, lines 2-5). Huttenlocher further teaches a structural document with an imaginary nonempty strip just above the top of the image which is used to compute the offset value (col. 23, line 64 – col. 24, line 7). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of Huttenlocher to the system in Dubbels since Huttenlocher also teaches a request for obtaining a resource from a server, discrimination of different formats and means for generating print data to be printed wherein the resource is written in HTML (Fig.10).

Claims 6-9 are method claims of apparatus claim 1-5. Claims 6-9 are rejected for the same rationales set forth for claims 1-5.

Concerning claim 10, Dubbels et al in view of Huttenlocher et al discloses a recording medium for recording a program for controlling a printer comprises module for performing the operations as discussed in claim 1 above.

Concerning claim 13, Huttenlocher further teaches that the structural means determines the page layout of the resource based on information relating to the size of data and information relating to the position of data and the setting means sets the pages to be printed in accordance with the determined page layout (col. 1, lines 29-38; col. 2, lines 2-32; col. 22, line 36 – col. 24, line 53; col. 26, line 15 – col. 28, line 31).

***Conclusion***

7. Applicant's arguments filed on January 02, 2003 have been fully considered but they are not persuasive.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

Application/Control Number: 09/442,152

Art Unit: 2622

Page 8

*Anh W. Nguyen*

AV

February 25, 2003

Madeleine AV Nguyen

Primary Examiner

Art Unit 2622